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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,818	12/19/2000	Antonio Alvarez Berenguer	2486-1-003	3449

7590

08/27/2003

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EXAMINER

MARCANTONI, PAUL D

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 08/27/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

A 324

<b>Office Action Summary</b>	<b>Application No.</b> 09/700,818	<b>Applicant(s)</b> ALVAREZ BERENGUER ET AL.	
	<b>Examiner</b> Paul Marcantoni	<b>Art Unit</b> 1755	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1755

Applicants 8/14/03 response is noted and the following rejection is provided in response to the examination of the non-elected claims which were included in the rejection below:

Claims 1-3 and 5-12 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

First, it is noted that applicants were requested to provide a listing of "all" claims as was stated in the PTOL-90 communication. Applicants did not present all of their claims because claim 12 was missing from the listing of their active claims. It is expected that applicants can provide this claim as an active claim (unless they cancel) in their next listing of claims.

Nevertheless, claim 12 is not only rejected as being indefinite but it is also rejected under 35 USC 101 because "Use of claims" are not allowable claims. It must be a machine, an article, a process, or a composition and "use of" falls outside what is permissible by the statute.

The terms "selected from" are not <sup>proper</sup> for Markush terminology in claim 1. Applicants should amend to --selected from the group consisting of---.

The terms "selected from among" are indefinite because again it is not proper Markush language in claim 9. Amendment to selected from the group consisting of is advised.

Claim 9 is indefinite because the term "special mortars" are indefinite. How do applicants define a special mortar?


Claim 9 is also indefinite because it would appear redundant. It repeats gypsum and the so called special mortar as a first component and then repeats a second gypsum component, a cement fraction, and aggregate fraction.

First, how does the first gypsum stated differ from the "gypsum fraction"? Is it the same or something else? Second, gypsum is a cement so it can be considered a cement fraction as well. How is the gypsum distinguished from the cement fraction? Also, how is special mortar distinguished from cement fraction?

More so, claim 9 is indefinite because applicants do not particularly point out and distinctly claim the fraction for their composition of claim 9. What is the fraction for each one? Applicants may consider not using the word fraction and just <sup>listing</sup> ~~listing~~ the material (ie gypsum and not gypsum fraction).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is (703)-308-1196. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (703) 308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
**PAUL MARCANTONI  
PRIMARY EXAMINER  
GROUP 1700**